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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF UTAH

VOLKSWAGEN GROUP OF  
AMERICA, INC., a New Jersey  
corporation,

Plaintiff,

v.

JOHN DOE, a person or entity whose  
identity is currently unknown,

Defendant.

Case No. 2:22-cv-00438-DBP

Judge: Dustin B. Pead.

**COMPLAINT**

Plaintiff Volkswagen Group of America, Inc. (“Plaintiff” or “VWGoA”) for its complaint against the registrant of the domain name *lithiavwmedford.com* (“Defendant”), alleges as follows:

1. VWGoA files this action under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d), against the registrant and cyberpirate of the domain name *lithiavwmedford.com*, whose identity is currently unknown, which is being used by the domain name registrant to operate a website that is designed to appear to be operated by a VW dealer when it is not.

### JURISDICTION AND VENUE

2. This Court has subject matter jurisdiction over this action pursuant to:

(a) The International Convention for the Protection of Industrial Property, 13 U.S. Treaties and Other International Agreements (1962), implemented by Sections 39 and 44 of the Lanham Act, 15 U.S.C. §§ 1121 and 1126, and by the Judicial Code, 28 U.S.C. § 1331;

(b) Section 39 of the Lanham Act, 15 U.S.C. § 1121, giving this Court jurisdiction over all actions arising under the Lanham Act without regard to the amount in controversy;

(c) Section 43(d) of the Lanham Act, 15 U.S.C. § 1125(d)(2)(A), relating to domain name cyberpiracy.

3. This Court has personal jurisdiction over Defendant because Defendant may reside in this judicial district.

4. Venue is proper in this judicial district because Defendant may reside in this judicial district.

### THE PARTIES

5. Plaintiff Volkswagen Group of America, Inc. (“VWGoA”) is a New Jersey corporation with a place of business in Herndon, Virginia.

6. VWGoA is the exclusive U.S. importer of cars manufactured by Volkswagen AG (“VW”) and is tasked with the responsibility of protecting the trademarks of VW in the United States.

7. Defendant is the person or entity who registered the domain name *lithiavwmedford.com*.

8. VWGoA has diligently tried to identify and contact the domain name registrant, but has been unable to do so. The WhoIs record for the domain name is redacted and includes no name or contact information for the domain name registrant. Through its outside counsel, VWGoA attempted to contact the domain name registrant through the domain name registrar, Dynadot, which responded by instructing VWGoA’s counsel to submit an abuse report. VWGoA’s counsel submitted an abuse report to Dynadot as directed, and Dynadot denied the request and informed VWGoA that VWGoA would need to file either a lawsuit and serve a subpoena or file a proceeding under the Uniform Domain Name Dispute Resolution Policy. A copy of the WhoIs record saved from Dynadot’s WhoIs database on June 29, 2022, is attached as Exhibit A. Accordingly, Plaintiff has filed this lawsuit against Defendant Doe in order to serve subpoenas on Dynadot

and, and to pursue Plaintiff's claims against Defendant once his or her identity is discovered.

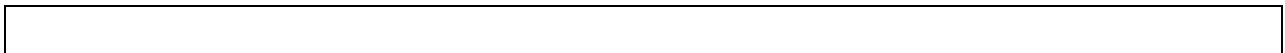
## FACTUAL BACKGROUND

### *VW's Trademark Rights*

9. The trademarks of VW that Plaintiff is authorized to use and responsible to protect in the United States include some of the most popular and valuable trademarks in the world. The VW® name and logo are world-renowned and are emblematic of the goodwill and commercial success of the VW brand.

10. VW obtained its first U.S. Trademark Registration for VW® in 1957 (U.S. Reg. No. 0,653,695) and has acquired many additional registrations for the VW® mark and related marks. A true and correct copy of VW's first U.S. registration certificate for VW® is attached as Exhibit B.

11. VW uses the VW® mark in connection with a design trademark or logo consisting of an encircled "V" and "W," known as the VW LOGO®, depicted below:





12. VW obtained its first U.S. Trademark Registration for VW LOGO® (U.S. Reg. No. 0,790,959) in 1965. A true and correct copy of VW's first U.S. trademark registration certificate for VW LOGO® is attached as Exhibit C.

13. VW holds additional registrations for VW® and VW LOGO® in many other countries throughout the world. VW® and VW LOGO® are hereinafter referred to as the "VW Marks." VW's registrations for the VW Marks are valid, unrevoked, subsisting, and incontestable, and constitute prima facie evidence of VW's exclusive ownership of the VW Marks.

*The Bad Faith Registration and Use of Lithiavwmedford.com*

14. *Lithiavwmedford.com* was registered on April 30, 2021—long after the VW Marks had become well known and famous worldwide.

15. New and certified used VW vehicles are sold through a network of VW dealers, which are authorized by VWGoA to conduct business under names that include VW, as specified in their dealer agreements. Dealers often use names comprised of VW and the business or family name of the dealer operating the dealership or a name indicative of the geographic area in which the dealership is

located, such as Medford. Lithia Motors, Inc. operates one of the largest networks of automotive dealerships in the United States, including a number of Volkswagen dealerships, such as Lithia Volkswagen of Des Moines, Lithia Volkswagen of Reno, and Honolulu Volkswagen. Lithia Motors also operates a number of automotive dealerships in Medford, Oregon, including Lithia Toyota of Medford and Lithia Honda in Medford. The domain name *lithiavwmedford.com* clearly means and refers to a VW dealership operated by Lithia Motors Inc.

16. Defendant uses *lithiavwmedford.com* to operate a website that has been designed to appear as if it is an authorized VW dealership, operated by Lithia Motors, Inc. The website displays the name “Lithia Volkswagen,” the VW LOGO®, and hyperlinks that resolve to the official website of Lithia Motors, Inc., which is located at *lithia.com*. A true and correct copy of the homepage of the website at *lithiavwmedford.com* is attached hereto as Exhibit D. The cyberpirate who has registered *lithiavwmedford.com* is advertising the sale of this domain name for \$1,499 as set forth in Exhibit E.

FIRST CLAIM FOR RELIEF  
(Cyberpiracy)

17. The allegations set forth above are incorporated herein by this reference.

18. VW® is a distinctive trademark and was a distinctive trademark at the time Defendant registered *lithiavwmedford.com*.

19. VW® is a famous trademark and was a famous trademark at the time Defendant registered *lithiavwmedford.com*.

20. Defendant has a bad faith intent to profit from VW® and confusingly similar variations of VW®.

21. Defendant has registered and used a domain name, namely, *lithiavwmedford.com*, that is identical to, confusingly similar to, or dilutive of VW®.

22. By reason of Defendant's cyberpiracy, VWGoA has suffered irreparable harm. Unless Defendant is restrained from further cyberpiracy, VWGoA will continue to suffer irreparable harm.

23. VWGoA has no remedy at law that will adequately compensate for the irreparable harm it will suffer if Defendant's conduct is allowed to continue.

24. As a consequence of Defendant's actions, VWGoA has suffered damages in an amount to be proven at trial.

25. VWGoA is entitled to an injunction transferring *lithiavwmedford.com* to VWGoA.

26. VWGoA is entitled to actual damages, statutory damages in the amount of \$100,000.00 pursuant to 15 U.S.C. § 1117(d), and recovery of its attorney's fees and costs.

WHEREFORE, VWGoA prays for judgment against Defendant as follows:

A. That Defendant, and all of Defendant's agents, servants, employees, and attorneys, and all other persons in active concert or participation with them who receive actual notice of the injunction, be temporarily, preliminarily, and permanently enjoined from, without permission from VWGoA:

(1) using the VW Marks, and any colorable imitations thereof, or any marks confusingly similar thereto, other than non-prominently, in purely informational statements;

(2) transferring to anyone other than to VWGoA the domain name *lithiavwmedford.com* or any other domain name that uses names, words, designations, or other symbols confusingly similar to the VW Marks; and

(3) registering, maintaining registrations for, using, offering for sale, claiming ownership of, or in any other way using *lithiavwmedford.com*, or any other domain name that uses names, words, designations, or other symbols confusingly similar to the VWt Marks;

B. That Defendant be ordered to disclose to the Court and to VWGoA all other domain name registrations owned or controlled by Defendant through any domain name registrar or registry in order to permit the Court and VWGoA to consider whether any such other registrations should be transferred to VWGoA or be subject to other relief in this matter;

C. That Defendant be ordered to transfer to VWGoA the registration for



*lithiavwmedford.com*, and any other domain name that uses names, words, designations, or other symbols confusingly similar to the VW Marks;

D. That VWGoA be awarded damages, and also punitive damages, for Defendant's oppressive, fraudulent, and malicious acts of cyberpiracy;

E. That VWGoA be awarded its reasonable attorney's fees and costs of suit under 15 U.S.C. § 1117(a);

F. That VWGoA be awarded be awarded statutory damages in the amount of \$100,000 pursuant to 15 U.S.C. § 1117(d); and

G. That VWGoA be awarded such other relief as the Court may deem just and proper.

Dated: June 30<sup>th</sup>, 2022

/s/ Gregory D. Phillips  
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